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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,155	09/21/2006	Gorm Sorensen	41081	1684

116 7590 08/07/2009
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EXAMINER	
MICHALSKI, SEAN M	

ART UNIT	PAPER NUMBER
3724	

MAIL DATE	DELIVERY MODE
08/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/598,155	SORENSEN ET AL.	
	Examiner	Art Unit	
	SEAN M. MICHALSKI	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35,38,40-44,48-54, 56, 59, 61, 63-65, 69-89* is/are pending in the application.

4a) Of the above claim(s) *40,48,61,69,73-77 and 79-83* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35,38,41-44,49-54,56,59,63-65,70-72,78 and 84-89* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 73-77, 79-83, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The new claims above each contain elements which are distinct from the pending and previously examined claims. For example, claim 73 requires that the data sets be "measured practically across the item transversely..." not required by claim 41, which requires a "scanning device" not required by claim 73. Similar two way distinctness is present between each new claim and the previously examined claims. There is a clear burden due to at least the presence of additional searching not previously required, and the newly added claims present possible 112 first and second paragraph issues which are not previously present.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 73-77 and 78-83 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35, 38, 41, 42, 43, 44, 49-54, 56, 59, 63-65, 70-72, 78, and 84-89 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification and figures do not enable one of ordinary skill in the art to make a device which can detect the boundary of items which are contacting and fed together into the scanning/measuring means. Applicant has set forth that the definition of abut should include items which contact—though this definition is not accepted as the broadest reasonable interpretation, if during subsequent revision (as by formal definition) it becomes clear that the proper construction of "substantially abutting" is to contact along a boundary, then examiner finds the claims as not enabled, as set forth below:

The specification describes essentially that the cross sections of the pieces are measured and that a change will indicate that there is a boundary/transition point. This is not enabling, however, because it does not take into account what the specific parameters of the computing methodology and measurement resolution are—information necessary to make and use the invention. Especially since food products are to be used which may have cross sectional variation *within* a piece (such as a chicken breast) making false boundary/transition point indication highly probable; and/or very uniform cross section (such as formed sausage product or pressed meat) making the boundary/transition point imperceptible. The specification does not provide any

framework to establish the parameters of the control/measurement to make and use the device in accordance with the claimed "no gap" between items.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 35 and 86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically the recitation that "the controlling step includes an item boundary detection step such that a point of transition between consecutive items on the conveyor means having no gap therebetween is *based on the at least one measured item characteristic*" (from 86, similar recitation omitting "having no gap..." in claim 35) makes no sense. How can a point of transition be based on a measured characteristic--the transition point is set before measurement. Only the *measurement* of a point of transition, or a *determination* of point of transition can be based on the measured characteristic.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 35, 38, 41, 42, 49-52, 56, 59, 63, 70, 71, 78, 84 and 85 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitehouse (WO 99/47885) as set forth previously regarding claims 35-39, 41,42,50-52, 55-60, 62, 63, 70 and 71.

As a general matter of claim construction the term "abutting" may mean being next to; adjacent (See "Abut" from MSN Encarta online dictionary at http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861583147, "**a·but** [ə bút] (*past and past participle* a·but·ted, *present participle* a·but·ting, *3rd person present singular* a·buts) Definition: **be adjacent:** to touch or be adjacent to something along one side"). Something which is "generally" or "substantially" abutting may be misaligned and fairly gapped and need not be contacting or touching.

It is reiterated that the device and method of Whitehouse discloses measuring the cross sectional area of the items as they are fed through the ring of sensors—which includes the step/ means for detecting a boundary, since where the cross sectional area is exactly 0, at a transition point/boundary between two items (touching or not), the boundary has been detected. Alternatively, to the extent the device as claimed is enabled to detect the boundary based on a change in measured data (essentially cross sectional area) so too can the Whitehouse device. The data being received by Whitehouse would show (and therefore detect) the boundary/transition at the minima of the measured cross sectional area.

Regarding claims 49 and 85 as set forth in a 103 rejection of the previous action, due to a now altered dependence : Whitehouse discloses that the height is the measured dimension of the item (the cross section is taken which includes the height).

7. Claims 86-89 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitehouse.

Whitehouse shows the items touching (fed in touching/no gap relation) in figure 3b (and there is no break in the conveyor to account for how they came to be abutting post sensor—they must be touching pre sensor in that embodiment). It is reiterated that the device and method of Whitehouse discloses measuring the cross sectional area of the items as they are fed through the ring of sensors—which includes the step/ means for detecting a boundary at a transition point/boundary between two items, the boundary has been detected. When products are fed in abutting relation into the sensor of the Whitehouse device, the boundary is detected even where there is "no gap". This can be seen in Whitehouse page 3 lines 17-21, "end proximity" and "product arrival and product departure signals" while viewing the figures 3b. Additionally, Since the length of products is determined (as in page 10 lines 20-22) in conjunction with the figure 3b (touching work pieces with no belt gap) the device must be capable of detecting a boundary between touching meat.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 43, 44, 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse in view of VanDevanter as set forth in the rejection of 11/19/2008.

10. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse in view of Antonissen as set forth in the rejection of 11/19/2008.

11. Claims 54 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse as set forth in the rejection of 11/19/2008.

Response to Arguments

12. Applicant's arguments filed 6/11/2009 have been fully considered but they are not persuasive.

Applicant alleges that the amendments to the claims place them in condition for allowance over the Whitehouse reference, which is not believed to be the case as set forth above. The enablement issues and clear support in the Whitehouse reference preclude finding that the no-gap feature defines over Whitehouse.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN M. MICHALSKI whose telephone number is (571)272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sean M Michalski/
Examiner, Art Unit 3724

/Kenneth Peterson/
Primary Examiner, Art Unit 3724